

## REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of March 11, 2008 and respectfully requests reconsideration of the application.

Claims 1-17 and 22-38 are now pending, a total of 34 claims. Claims 1, 6, 9, 15, 25, 27 and 30 are independent.

If and only if a further Action is prepared that corrects all of the omissions and defects discussed below, Applicant provisionally elects Group I, claims 1-8, 15-17 22-29 and 36-38, with traverse. If any defect remains outstanding or if there is any failure to “Answer All Material Traversed,” Applicant notes that any requirement will be automatically dissolved, and all claims will remain in prosecution.

### I. Restriction Requirement

The statement of the Restriction Requirement is flawed in so many respects that (a) it is too procedurally flawed to raise any requirement, and (b) Applicant is unable to make an informed or binding election based on the poor disclosure of the basis for the requirement.

#### A. The Search Classifications are Incorrect

All claims are most efficiently searched in 463/18. The designations of 463/29 and 463/26 are inconsistent with the class definitions.

The Office Action proposes to search Group I, of which claim 1 is representative, in 463/29. Claim 1 reads as follows:

1. A method comprising the steps of:

from among races at an event having a plurality of horse races, allowing a player to choose winners of each of a plurality of the event's races to be included in a unified wager, the choices available to the player permitting the player to choose horses in a non-consecutive plurality of races from among the event's races; and

paying the player if a number of the selected winners within the unified wager win corresponding chosen races.

The Office Action proposes to search claim 1 in 463/29:

29 Access or authorization (e.g., game selection, security, etc.): This subclass is indented under subclass 1. Electronic data processing including: (a) means for determining whether a participant has a right or privilege to input into, acquire, or use the electronic data; (b) means to allow or prevent such input, acquisition, or use of said data based upon a right or privilege; or (c)

means for controlling acquisition, selection, or use of a particular subset of data (e.g., particular game, etc.) in a set of data (e.g., plural games, etc).

There is no apparent relationship of claim 1 to 463/29: claim 1 recites no “right or privilege,” “means to allow or prevent input,” or other “access or authorization” before the player places a bet. In contrast, claim 1 fits the definition of 463/18, because the races are the “lots” and the player’s bets are the “predetermined event,” and more than one race/lot is compared to determine the outcome.

- 16 **In a game of chance (e.g., lot, etc.):** This subclass is indented under subclass 1. An electronic data processing application having an outcome that relies solely upon a happening (i.e., event) absent of any apparent cause or design (i.e., an unpredictable or random event), or includes an object (i.e., lot) used to so randomly determine a matter or represent the outcome of a random event (e.g., electronic dice or random number generator, etc.).
- 17 **Lot match or lot combination (e.g., roulette, lottery, etc.):** This subclass is indented under subclass 16. A chance event application wherein a particular characteristic of a lot is compared to a characteristic of either another lot or some other predetermined object, indicia or event, and further wherein the chance event relied upon is a determination of a substantial likeness in character (i.e., match) made by the comparison according to a predetermined rule or rules, or a determination that an ordered set or association is created when more than one lot is compared.
- 18 **Plural lots (e.g., keno, etc.):** This subclass is indented under subclass 17. Subject matter wherein more than one lot is compared.

Similarly, Group II is misclassified. The Office Action proposes to search claim 9 in 463/26. Claim 9 and the definition for 463/26 read as follows:

9. A computer assisted method, comprising the steps of:
- receiving from each of a plurality of players respective selections of predicted winners for each of a plurality of races at the racing event the selections available to each player permitting the player to choose horses in a non-consecutive plurality of races from among the event’s races, the selections of each player included in respective unified respective wagers corresponding to respective players;
  - receiving from each of the plurality of players a bet associated with the wager corresponding to that player;
  - pooling at least a portion of each bet to form a pool;
  - receiving results from races within the racing event;
  - identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and
  - sending at least a portion of the pool to one or more identified winning players.

- 26 **Pool amount (e.g., jackpot, etc.):** This subclass is indented under subclass 25. Credit/debit monitoring or manipulation including a means to account for

the value of a sum (i.e., pool) of money or money equivalent wagered by or collected from one or more participants or gaming machines for the purpose of subsequent distribution of an amount of said pool as an award or prize to a participant that has reached or accomplished a defined goal in a contest; or means for determining or causing the distribution of said amount from said pool.

Claim 9 is not directed to determining the amount of the pool as required by 264/25 but rather to determining the outcome and distribution of the pool based on several horse races, the “determination” to determine the “outcome” based on “more than one lot,” which places claim 9 in 463/18.

**B. Essential Showings are Missing**

The “combination/subcombination” form paragraph requires a showing that the claims “do not overlap in scope.” However, the Office Action explains that the claims do overlap in scope, in that both Groups I and II cover embodiments with multiple players making bets into a pool.

The Office Action does not identify which claims are directed to the combination and which are directed to the subcombination, and that relationship is not apparent. Thus, Applicant is unable to exercise the invitation in the Office Action alluding to MPEP § 821.04(a). Without a complete explanation of grounds, no informed election can be made.

**C. The Showing of “Serious Search Burden” is Faulty**

MPEP § 803(I)(B), § 803(II) ¶ 4, and § 806.01 requires “Examiners must provide reasons and/or examples to support conclusions” of “unduly extensive and burdensome search,” for example, by “appropriate explanation of separate classification, or separate status in the art, or a different field of search.” The statements in the Office Action do not relate to the grounds stated in MPEP § 803(II) ¶ 4. Applicant is unable to reply until the Examiner has stated “reasons and/or examples to support conclusions” that relate to relevant criteria.

To Applicant’s knowledge, “different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112 , first paragraph” are nowhere authorized as a basis for restriction, or as an alternative to “undue burden of search.” If the reasoning used in the Office Action is authorized anywhere in the MPEP, Applicant requests identification. If no such authorization can be identified, Applicant requests that examination be conducted according to the PTO’s written regulations and guidance.

## II. Election of Species

The basis for the election of species requirement is not clear. What is the basis for distinguishing between the “plurality of players” of claim 9 vs. the “first player” and “second player” of claim 30?

To the extent that the election of species requirement relies on claim 33 (the claim that recites the “third wager” mentioned in the Action), Applicant notes that claim 36 (dependent on claim 9) recites similar language in terms similar enough to claim 33 to establish that no division of these groups is warranted.

The Action asserts that the groups are mutually exclusive, but alludes to no facts and makes no showings suggesting that this would be true. This violates MPEP § 803(I)(B), § 803(II) ¶ 4, and § 806.01.

In addition, the Election Requirement is incomplete in at least the following respects:

- MPEP § 809.02(a)(B) requires that an Action identify the characteristics of the disclosed species among which election is proposed that establish the basis for division and classification, for example:
    - figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified.
- The Action fails to comply with § 809.02(a)(B). Why are these groups restricted from each other? Without some identification of the basis for grouping, Applicant is unable to comply with the request to designate the claims “readable” on that group, or to identify the claims that are generic.
- The Action makes no showing of “serious search burden,” as required by MPEP § 809.02(a) and 808.02 and note 4 to form paragraph 8.01. The Action asserts that the groups might require a different field of search, but earlier admitted that claims 9 and 30 are to be searched in the same field.

Because the Office Action is so internally contradictory and incomplete, the Action is too procedurally incomplete to require an election, and Applicant cannot make an informed designation of claims to be examined.

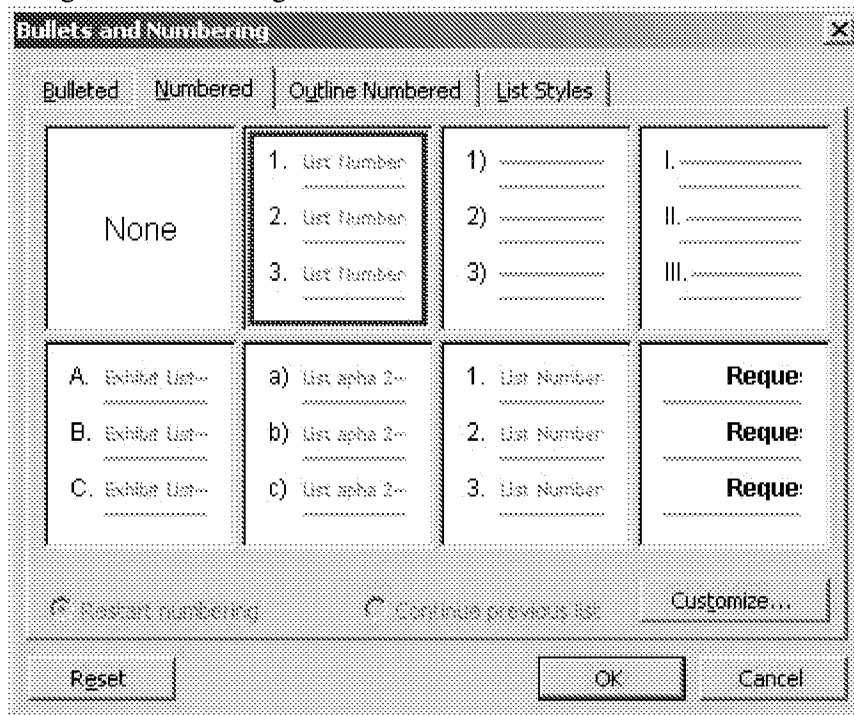
### III. Designation of Paragraphs in the Office Action

The Examiner's attention is drawn again to MPEP § 707.07(k):

#### 707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.

The examiner's attention is also drawn to the menu in Microsoft Word, Format > Bullets and Numbering, which gets to this dialog box:



The Examiner will observe that this Reply paper is remarkably less clear than it would have been had there been paragraph numbers in the Office Action to which to refer.

### IV. Conclusion

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely.

Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 04-7131.

Respectfully submitted,

Dated: May 12, 2008

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